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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,399	04/08/2004	Edward L. Johnson SR.	10968-1	8418

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National IP Rights Center, LLC
Suite 400
550 Township Line Road
Blue Bell, PA 19422

EXAMINER

WENDELL, MARK R

ART UNIT	PAPER NUMBER
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3609

MAIL DATE	DELIVERY MODE
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06/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,399

Applicant(s)

JOHNSON, EDWARD L.

Examiner

Mark R. Wendell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: Page 2, line 2 the word "good" should be replaced with "well." Page 2, line 3, a comma should be inserted between the words "that new." Page 2, lines 4-6 should be re-worded to follow proper English grammar.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Regarding claim 10, the phrase "can be installed" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Holcomb (US 2114710). Holcomb discloses and illustrates in Figures 1, 2, and 5 a device for installing ceramic tiles comprising:

- A sheet (6) having a top and bottom face adapted to mounting on a surface (13, 14);
- A grid (9, 10) formed into the top face of the sheet (6) for receiving ceramic tiles (8).

Regarding claims 2 and 3, Holcomb discloses the sheet (6) being made from an elastomeric material (Page 1, column 2, lines 1-5). The examiner also notes that rubber is also a synthetic material.

Regarding claim 4, Holcomb illustrates in Figures 1 and 2 a device for installing ceramic tile being substantially square. The examiner also notes that on Page 2, column 2, lines 8-9, Holcomb discloses the device to be rectangular. It is notoriously well known that a square is a rectangle with sides of equal length.

Regarding claims 5 and 7, Holcomb discusses within the specification a method of installing ceramic tile using the device disclosed above. Holcomb discloses mounting the sheet (6) on a surface (13, 14) on Page 2, column 2, lines 26-35. Holcomb further

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describes the tile (8) being placed and secured within the grid (6, 9, 10) in lines 35-42 of Page 2, column 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holcomb (US 2114710) in view of Bethea (US 4324605). It is described above what is disclosed by Holcomb. However, Holcomb fails to disclose the method step of securing the tile (8) in the grid (6, 9, 10) by pressing it with a rubber mallet. Bethea discloses in claim 1, lines 15-16, pressing the ceramic tile into an adhesive. The examiner notes that it is well known within the art of building construction to use a rubber mallet to forcibly press an object with adhesive to another object. It would have been obvious to one of ordinary skill in the art at the time of invention, with the motivation of getting the tile and adhesive to readily stick to the floor or grid, to combine the method set forth in Holcomb with the act of further pressing the tile to the floor (disclosed in Bethea) using a rubber mallet.

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Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over BuildDirect.com in view of Holcomb (US 2114710). BuildDirect.com discloses a method of installing ceramic tile including:

- Measuring and drawing the area to be tiled;
- Removing floor moldings;
- Cutting tile sheets to the necessary size;
- Laying the sheets on the floor;
- Pressing tile and adhesive onto the floor
- Replacing the floor moldings.

However BuildDirect.com does not disclose using a grid formed into the top face of the sheet. Holcomb disclose a sheet and grid structure for installing ceramic flooring as described above. It would have been obvious to one of ordinary skill in the art to incorporate the grid structure of Holcomb, and step of placing the tile into the grid, into the method steps of BuildDirect.com with the motivation of saving time and making the job simpler.

Regarding claim 10, installing reducer strips is not a necessary step within the method since the applicant has used the phrase "can be installed" (see 112 rejection above). BuildDirect.com discloses the method step of placing a bead of caulk between wall and floor joints. The examiner notes that it is notoriously well known within the art of building construction that caulk is a silicon agent and is widely used as a waterproofing medium for flooring, bathtubs, sinks, etc.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Solano (US 5806270) teaches a grid system for laying ceramic tile. Both Nelson (US 6230385) and Stearns (US 6068904) teach reducer strips for leveling objects. Feicher et al. (US 3444660) teaches pre-grouted ceramic tile assemblies. Pottinger (US 2266510) teaches a method of making building panels using a grid like structure. The examiner notes that the method of installing ceramic tile within a grid structure is old and well known within the art of building construction. It is also common practice, and can be found in many how-to manuals, that when replacing a floor to measure the area, remove moldings, cut the tile, lay sheets on the floor, replace moldings, and caulk the wall/floor joints.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Wendell whose telephone number is (571) 270-3245. The examiner can normally be reached on Mon-Fri, 7:30AM-5PM, Alt. Fri off, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on (571) 272-6987. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Victor Batson
Supervisory Patent Examiner
Art Unit 3609

MW

June 11, 2007